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In re Application of :
Ternansky et al. :
Application No. 10/590,576 :
PCT No.: PCT/US05/05985 :
Int. Filing Date: 23 February 2005 : DECISION
Priority Date: 23 February 2004 :
Atty. Docket No.: 9715-046-999 :
For: Formulations Of Thiomolybdate Or :
Thiotungstate Compounds And Uses Thereof :

This is in response to the petition under 37 CFR 1.47(a) filed on 19 November 2007, which is also being treated under 37 CFR 1.42.

BACKGROUND

This international application was filed on 23 February 2005, claimed an earliest priority date of 23 February 2004, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 23 August 2006. Applicants filed, *inter alia*, the basic national fee on 22 August 2006.

On 18 April 2007, a Notice of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

DISCUSSION

Issues Under 37 CFR 1.42

Review of the declaration of the inventors filed on 19 November 2007 reveals that joint inventor Brian Sullivan has not signed. The petition indicates that he is deceased, and that Carol Sullivan is his legal representative. 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state

that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Further examination of the declaration reveals that it lists the citizenship, postal and residential information for the deceased inventor, but it neither identifies nor provides the citizenship, postal and residential information for the legal representative. The petition includes a copy of a separate "DECLARATION Supplemental Sheet," but it appears that this Supplemental Sheet was never integrated with the remaining sheets to form a complete declaration document for presentation to the legal representative. MPEP 201.03 explains in part that

While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Therefore, the declaration fails to satisfy the requirements of 37 CFR 1.497(b)(2). As such, it would not be appropriate to accept the declaration under 37 CFR 1.42.

Petition Under 37 CFR 1.47(a)

Petitioner requests that absence of the signature of legal representative Carol Sullivan be excused on the basis that she refuses to execute the application. A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding **requirement (1)**, the \$200.00 petition fee was paid on 19 November 2007.

Regarding **requirement (2)**, the "Declaration of David Kerwick..." and attached copies of correspondence establish that Carol Sullivan refused to execute a "DECLARATION Supplemental Sheet" provided to her (a copy of the published international application also having been provided). However, it is not clear that Ms. Sullivan was ever presented with a complete copy of the declaration document (i.e., a declaration nominating the entire inventive entity and naming her as Brian Sullivan's legal representative). Clarification of this point is required. See MPEP 409.03(d).

Regarding **requirement (3)**, the petition states the last-known address of the non-signing legal representative, Carol Sullivan. Accordingly, requirement (3) has been satisfied.

Regarding **requirement (4)**, the declaration of inventorship accompanying the instant petition nominates the entire inventive entity, and is signed by the other two joint inventors, but it does not identify the legal representative as discussed above.

CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.42, without prejudice.

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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